

U.S. Serial No. 10/761,552 (Attorney Dkt: HALB:020D1)
Art Unit: 1712

REMARKS/ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks.

II. Disposition of Claims

Claims 24, 33, 34, and 37-39 are pending in this application. In this Response, claim 24 has been amended.

III. Claim Rejections—35 U.S.C. § 112

The Examiner has rejected claims 24, 33, 34, and 37-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has stated that, “The amended endpoints of the ranges of percentages of the component of the continuous phase of the invert emulsion find so support in the original disclosure or claims.”

Applicants respectfully traverse these rejections. While still traversing any suggestion that Ashjian may contain or render obvious Applicants’ invention, Applicants respectfully submit *arguendo* that the facts of the prosecution indicate that Applicants have done no more with the endpoints than what the Court of Customs and Patent Appeals approved in *In re Johnson and Farnham*, 558 F.2d 1008, 194 U.S.P.Q. 187 (CCPA 1977), as “merely excising the invention of another, to which they are not entitled, and are not creating an ‘artificial subgenus’ or claiming ‘new matter.’” As the Court indicated, the factual context out of which a question under Section 112 arises is not immaterial. The “written description” in Applicants’ specification supported the claims in the absence of the endpoint limitations, and the “specification having described the whole, necessarily described the part remaining.”

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IV. Claim Rejections—35 USC § 102 or 35 USC § 103

The Examiner has rejected all pending claims 24, 33, 34 and 37-39 as anticipated by, or as obvious from, U.S. Patent No. 5,691,281 to Ashjian. Specifically, the Examiner has stated that:

Ashjan teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65) comprising a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms (Column 3 Lines 51-59 and Column 6 Line 38-Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

Ashjan does not disclose expressly esters being present at form at least about 46 weight percent of the blend; however, Ashjian reads on the instant claims because the instant claims use the term “about at least 46 weight percent”—which could be construed to include 45 weight percent—and because it has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in the range or value is minor. *Titanium Metals Corp. of Am. V. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). If there is any difference between the product of Ashjian and the product of the instant claims the difference would have been minor and obvious.

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

Applicants respectfully traverse these rejections for the reasons stated in response to the previous office action, incorporated herein by reference, and for the further reasons stated herein. Applicants have further amended claims 24 herein to delete the term “about” before the endpoints specified for the claimed ranges. There cannot be identity of the invention, however the claim may be interpreted with respect to Ashjan, and therefore Ashjan cannot anticipate this claim.

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The law is well established that for anticipation under Section 102, the Examiner must find "identity of invention." That is, the claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order for the reference to anticipate. *Eg., Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566, 1567, 1568 (Fed. Cir. 1990)(every element of the claimed invention must be identically shown in a single reference and these elements must be arranged as in the claims under review). The prior-art embodiments "must possess the properties expressly recited in the claims." *Eg., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988). "When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate." *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q.2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 U.S.P.Q.2d 1956 (Fed. Cir. 1989), citing *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Applicants respectfully submit that the Ashjian reference fails to have identity of invention with Applicants claims. The word "ester" appears only once in the entire Ashjian reference, in the context as follows, from Col 6, lines 28-33:

Although various combinations of hydrocarbons and other materials such as esters may be used, blends of the olefin isomers with (i) a light paraffinic oil with essentially no aromatic content and (ii) an olefin component, will normally give good blend viscometrics, flash point, bioacceptability as well as favorable product economics. In blends of this type, the mineral oil component is a mixture of C.sub.10 -C.sub.18 n-paraffins and C.sub.10 -C.sub.32 olefins of low viscosity suitable for formulation into the well fluids after the addition of the olefin isomer component.

It is not entirely clear what the "hydrocarbons" are that are being referenced in the first line quote above. Previously, it was believed from context that they were olefin isomers.

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However, it may be instead that the hydrocarbons being referenced are paraffinic hydrocarbons or mineral oil hydrocarbons. Thus, the one time, one word reference to “esters” in the Ashjian reference may be indicating that paraffin hydrocarbons or mineral oil hydrocarbons may be mixed with esters, but that a mixture of olefin isomers with a light paraffinic oil and an olefin component would “give good blend viscometrics, flash point, bioacceptability as well as favorable product economics.” While the Ashjian reference teaches various paraffin and olefin combinations and refers to hydrocarbon blends of paraffins and olefins throughout, the one-time appearance of the word “esters” in the context quoted above is not a teaching or anticipation of the blend of Applicants’ invention, namely isomerized olefins and paraffin hydrocarbons blended with esters. To further distinguish, Applicants have amended claim 24 to recite specific proportions of the blend components, namely, that the esters comprise at least about 46 weight percent and less than about 99 weight percent of the blend, the paraffin hydrocarbons comprise less than about 54 weight percent of the blend, and the isomerized olefins comprise less than about 54 weight percent of the blend. Applicants do not believe that the Ashjian reference teaches any amount of esters that may be used with paraffin hydrocarbons blended with isomerized olefins and respectfully submit that only with improper hindsight, using Applicants’ own teachings, can the ratios be obtained that the Examiner attributes to the Ashjian reference.

The Examiner has stated that the one time mention of “esters” in Ashjian “is a sufficient teaching to read on the instant claims.” Applicants respectfully disagree. The determination of obviousness is measured not by a subjective standard of quality but by an objective standard of inquiry. Hindsight reconstruction of prior art is not the applicable standard. *Maschinenfabrik Rieter A.G. v. Greenwood Mills*, 340 F. Supp. 1103, 173 U.S.P.Q. 605, 610, 611 (S.C. 1972).

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Section 103 requires having to show obviousness of the invention “as a whole.” To evaluate obviousness, a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. *In re Langer and Haynes*, 465 F.2d 896, 175 U.S.P.Q. 169, 171 (C.C.P.A. 1972). The burden of establishing a *prima facie* case of obviousness falls upon the Examiner. Therefore, the evidence upon which the Examiner relies must clearly indicate that a worker of routine skill in the art would view the claimed invention as being obvious, as meant by 35 U.S.C. § 103. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). There is nothing in the statutes or the case law which makes “that which is within the capabilities of one skilled in the art” synonymous with obviousness. *Ex parte Gerlach and Woerner*, 212 U.S.P.Q. 471 (PTO Bd. App. 1980).

Anticipation and obviousness are separate and distinct concepts. *Jones v. Hardy*, 727 F.2d 1524, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984). Although the Examiner has not used the term “inherency” or “inherent” in his rejections, he may be relying on or employing the guidelines of MPEP 2112, which provides that: “the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection” where the Examiner considers that the “applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference . . . [and further that] [t]his same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. . . .”

Applicants respectfully submit that the Examiner has not met his obligation under MPEP 2112 Part IV, which states:

Examiner Must Provide Rationale or Evidence Tending to Show Inherency

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re*

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Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) > Also, "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004)<

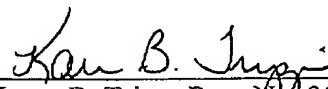
"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis added).

Applicants respectfully submit that the Examiner has failed to meet his burden prescribed by MPEP 2112. The Examiner has merely posited that the composition of Applicants' invention has certain common elements with products in the cited reference.

Applicants respectfully request that the Examiner withdraw his rejections based on the Ashjian reference. Applicants further respectfully request that the Examiner enter the amendments and allow the application to proceed to issue.

Respectfully submitted,

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